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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,765	05/05/2005	Marc Poirot	0505-1037	6680
⁴⁶⁵ YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			⁷⁵⁹⁰ EXAMINER BADJO, BARBARA P	
			ART UNIT	PAPER NUMBER
			1628	
			MAIL DATE	DELIVERY MODE
			10/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,765

Applicant(s)

POIROT ET AL.

Examiner

Barbara P. Badio

Art Unit

1628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12-19 and 26 is/are rejected.
- 7) ☒ Claim(s) 2-11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

2. The objection to claims 7 and 8 under 37 CFR 1.75(c) as being in improper form is withdrawn.

Double Patenting

3. The objection to claims 20-25 under 37 CFR 1.75 is made moot by the cancellation of the instant claims.

Claim Rejections - 35 USC § 112

4. The rejection of claims 22, 25 and 27 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement is made moot by the cancellation of the instant claims.
5. The rejection of claim 26 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement is withdrawn.

6. The rejection of claims 2-6 and 9-11 under 35 USC 112, second paragraph is withdrawn.

7. The rejection of claims 20-25, 27 and 28 under 35 USC 112, second paragraph is made moot by the cancellation of the instant claims.

8. The rejection of claims 1, 12-19 and 26 under 35 USC 112, second paragraph is maintained.

According to applicant, (a) claim 1 was amended to recite the features in a definite manner, (b) the solvents A, B, C and E and activator D are broadly described in claim 12, (c) breadth is not to be equated with indefiniteness and (d) solvents A, B, C and E and activator D are further defined in the dependent claims. Applicant's argument was considered but not persuasive for the following reasons.

First, as discussed in the previous Office Action, the use of the phrase "**may be**" in the definition of variables creates confusion as to what said variables are if not as recited by instant claim 1.

Second, the examiner agrees that the breadth of a claim is not to be equated with indefiniteness. The issue with the recitation of solvents A, B, C and E and activator D in claim 12 is not breadth but clarity. It would unclear to the skilled artisan in the art what applicant means by solvent A, solvent B, solvent C and solvent E and activator D since definition of said solvents and/or activator are missing from the instant claims.

Lastly, applicant argues the dependent claims define solvents A, B, C and E and activator D. However, claim 12 does not contain said definitions and the dependent claims do not define what is meant by each of solvent A, B, C and E and activator D.

For these reasons and those given in the previous Office Action, the rejection of The rejection of claims 1, 12-19 and 26 under 35 USC 112, second paragraph is maintained.

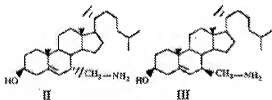
Claim Rejections - 35 USC § 102

9. The rejection of claims 20-25 under 35 USC 102(b) over El Kihel et al. (Anticancer Research, 1999) is made moot by the cancellation of the instant claims.

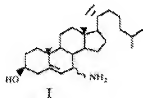
10. The rejection of claims 1 and 19 under 35 USC 102(b) over El Kihel et al. (Anticancer Research, 1999) is maintained.

Applicant argues the compound cited by the Office Action is actually excluded by claim 1 and, thus, the reference fails to anticipate the instant claims. Applicant's argument was considered but not persuasive for the following reason.

The compound excluded by claim 1 has the following structure:



. The compound cited in the previous Office Action is



wherein Q₁ is NH₂ because n0 is not 1 as recited by the proviso.

For this reason and those given in the previous Office Action, the rejection of claims 1 and 19 under 35 USC 102(b) over El Kihel et al. (Anticancer Research, 1999) is maintained.

Claim Rejections - 35 USC § 103

11. The rejection of claims 20-25, 27 and 28 under 35 USC 103(a) over El Kihel et al. (Anticancer Research, 1999) is made moot by the cancellation of the instant claims.

12. The rejection of claims 1, 19 and 26 under 35 USC 103(a) over El Kihel et al. (Anticancer Research, 1999) is maintained

Applicant argues (a) the instant claims differ from the cited reference by the compounds defined and (b) said difference results in compounds that are able to induce, in vitro, dendritogenesis, neuritogenesis and/or the production of secretory vacuoles in various tumoral cell lines. Applicant also argues, the reference is only concern with in vitro cytotoxicity activities but (a) does not produce inevitably an in vivo antitumor effect and (b) does not measure the cytotoxicity in vivo. Applicant's argument was considered but not persuasive for the following reason.

As noted above in #10, the compound cited in the previous Office Action is encompassed by the instant claims. The instant claims are inclusive of homologs of the cited compound which are considered prima facie obvious.

The fact that the prior art does not provide in vivo data is not relevant to the patentability of the compound or composition. Additionally, identical compounds would be expected to have identical properties and, thus, one of skilled in the art would have the reasonable expectation that the compound of El Kihel would have all the properties of the claimed compounds.

For these reasons and those given in the previous Office Action, the rejection of claims 1, 19 and 26 under 35 USC 103(a) over El Kihel et al. (Anticancer Research, 1999) is maintained.

Claims Objections

13. Claims 2-11 are objected to as being dependent upon a rejected base claim.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/
Primary Examiner, Art Unit 1628